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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/036,851 | 12/21/2001 | Tom R. Belau | KCC 4844 (KC# 16,629) | 4045 |

7590 10/08/2003

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| EXAMINER | |
|---|---|
| SALVATORE, LYNDA | |
| ART UNIT | PAPER NUMBER |
| 1771 | |

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/036,851 | BELAU ET AL. | |
| | Examiner | Art Unit | |
| | Lynda M Salvatore | 1771 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *21 December 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-36,38,39 and 42-61* is/are pending in the application.

4a) Of the above claim(s) *39 and 42-61* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-36 and 38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-36,38 drawn to a patterned un-bonded non-woven fabric, classified in class 442, subclass 327+.

   II. Claims 39,43-59 drawn to a disposable article, classified in class 604, subclass various.

   III. Claims 42 and 61 drawn to process for making an un-bonded non-woven fabric, classified in class 28, subclass various.

   IV. Claim 60 is drawn to a mechanical fastener, classified in class 24, subclass various.

2. The inventions are distinct, each from the other because:

Inventions Group I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful a single layer wipe, or absorbent sheet and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either

instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions Group I and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the patterned non-woven web may be formed using embossing plates, needle punching, or water jets.

Inventions Group I and IV are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful a single layer wipe, or absorbent sheet and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Inventions Group III and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the

different inventions the method of Group III does not produce the mechanical fastener of Group IV.

Inventions Group II and IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the disposable article set forth in Group II does not require the mechanical fastener of Group IV or vice versa. (i.e., the mechanical fastener does require the presence of the disposable article)

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Richard Bridge a provisional election was made with traverse to prosecute the invention of Group I claims 1-36, and 38 Affirmation of this election must be made by applicant in replying to this Office action. Claims 39 and 42-61 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Applicant is advised that the reply to this requirement to complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-20 and 38 are rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Stokes et al., US 5,858,515.

The patent issued to Stokes et al., teaches a patterned un-bonded non-woven fabric having continuous bonded areas defining a plurality of discrete unbonded areas , which is suitable for use as an improved loop fastening material for hook and loop fastening systems (Abstract). Stokes et al., teaches that discrete unbonded areas function as fluid flow points or channels (Column 5, 1-15). Stokes et al., discloses that the fibers within the discrete unbonded areas are dimensionally stabilized by the continuous bonded areas that surround each unbonded area (Column 3, 5-10). The patterned non-woven fabric may be a spun-bonded non-woven, air-laid, or bonded carded web made from single, multi-component filaments, melt-spun or staple

fibers (Column 3, 20-25, Column 7, 1-20 and Column 9, 50-55). The patterned un-bonded non-woven fabric is also highly suited for use as a filtration material, a fluid management or distribution material for personal care absorbent articles (Column 4, 61-65). Stokes et al., also teaches the patterned unbonded non-woven web can be attached or bonded to a layer of film (Column 6, 15-20). With regard to claim 9, Stokes et al., teaches securing the patterned unbonded to an outer layer and a body liner to form a disposable personal care article (Column 13, 5-30). Suitable liner materials include non-woven webs (Column 13,25-27). The percent of bond areas ranges from about 25% to about 50% (Column 11, 64-67).

With regard to the difference in characteristic of opacity level, tensile strength, stiffness, and fluid flow within the patterned unbonded non-woven web as set forth in claims 10-20, Stokes et al., fails to set forth these physical characteristics, however, it reasonable to presume that said characteristics are inherent to the invention of Stokes et al. Support for said presumption is found in the use of like materials (i.e., made from single, multi-component filaments, melt-spun or staple fibers) and like processes (i.e., the formation of a patterned unbonded non-woven web having continuous bonded areas defining a plurality of discrete unbonded areas), which would result in the claimed physical properties. The burden is upon the Applicant to evidence otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the presently claimed physical characteristics would obviously have been present once the Stokes et al., invention is provided. *In re Best*, 195 USPQ 433

9. Claims 21-36 and 38 are rejected under 35 U.S.C. 102 (b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Krusko, US 3,766,922.

The patent issued to Krusko teaches an absorbent pad comprised of a fluff batt of cellulosic fibers having differing embossed regions (Column 6, 5-10, and Figure 3). The absorbent pad contains three embossed regions, two identical outer regions separated by a differing middle region (Figure 3). Krusko teaches that such an embossed configuration provides a series of peaks and valleys/channels, which allows for good fluid distribution throughout the absorbent pad (Column 7, 5-20). With regard to the plurality of discrete unbonded areas and continuous bonded areas, embossing would inherently provide these areas.

With regard to claim 22, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138

With regard to the difference in characteristic of opacity level, tensile strength, stiffness, and fluid flow within the patterned unbonded non-woven web as set forth in claims 26-36, Krusko fails to set forth these physical characteristics, however, it reasonable to presume that said characteristics are inherent to the invention of Krusko. Support for said presumption is found in the use of like materials (non-woven cellulosic fibrous batt) and like processes (i.e., a embossed non-woven having differing regions of patterns), which would result in the claimed physical properties. The burden is upon the Applicant to evidence otherwise. *In re Fitzgerald* 205 USPQ 594

In addition, the presently claimed physical characteristics would obviously have been present once the Krusko., invention is provided. *In re Best*, 195 USPQ 433

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 5,399,174

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

September 28, 2003
ls

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700